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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/606,117      | 06/24/2003  | Alan Y. Chow         | 3614/172            | 3694             |

23418 7590 08/09/2006

VEDDER PRICE KAUFMAN & KAMMHOLZ  
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CHICAGO, IL 60601

EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3766

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                    |               |  |
|------------------------------|--------------------|---------------|--|
| <b>Office Action Summary</b> | Application No.    | Applicant(s)  |  |
|                              | 10/606,117         | CHOW, ALAN Y. |  |
|                              | Examiner           | Art Unit      |  |
|                              | Frances P. Oropeza | 3766          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/24/06 (Election).
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-26, 29 and 31-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/ Restriction***

1. Claims 1-26, 29 and 31-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/24/06.

The Applicant elected species VII and defined claims 1-10 and 23-26 reading on the elected species. The Examiner disagrees. Independent claims 1 and 23 claim a return electrode distant from the eyeball – a limitation associate with figure 11 and not with elected figure 15. The examiner finds claims 27, 28 and 30 read on elected figure 15, hence claims 1-26, 29 and 31-39 are withdrawn from further consideration.

The Applicant asserts in the arguments of 5/24/06 that a generic claim is presented. The Examiner disagrees. There is no claim that reads on all eleven species claimed by the Applicant, hence there is no claim deemed generic.

The Applicant asserts in the arguments of 5/24/06 that the restriction is improper as it is not burdensome for the Examiner to examine all submitted claims. The Examiner disagrees. The application contains 11 disclosed species, and the burden to examine one species versus examining eleven species is significant, hence the restriction is deemed appropriate.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 27, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Abreu (US 6423001). Abreu teaches a method for treating degenerative retinal disease by chronically applying at least one stimulating electrode to an external surface structure of an eyeball, applying at least one return electrode to a second external surface structure of the eyeball, and applying electrical stimulation to the eyeball via the stimulating electrode and the return electrode (figure 59C; col. 20 @ 30-45; col. 92 @ 23-45; col. 94 @ 66 – col. 95 @ 4).

***Information Disclosure Statement***

4. The information disclosure statement filed 3/10/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. None of the foreign patent documents and none of the non-patent literature documents were submitted. The information disclosure statement has been placed in the application file with the foreign patent documents and the non-patent literature documents lined through. The information referred to the foreign patent documents and the non-patent literature documents has not been considered.

*Drawings*


5. The drawings are objected to because the Examiner is unable to find the reference numeral " 70", "152", "159", "171" and "172" of figure 1 in the instant specification. A proper drawing correction or corrected drawing is required in reply to this Office action to avoid abandonment of the application. The correction to the drawing will not be held in abeyance.
6. At least figure 13 is hand drawn. At the time of allowance, formal drawings are suggested.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3766

JPO  
8/6/06

  
Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3766